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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Sole Applicant: David Tropp
Application no. 10/706,500
Title: **METHOD OF IMPROVING AIRLINE LUGGAGE INSPECTION**

Office Action 08-26-2005

Examiner Edwyn Labaze
Art Unit 2876

DECLARATION OF PRIOR INVENTION PURSUANT TO 35 U.S.C. § 1.131

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

STEVEN HOROWITZ, declares as follows:

1. I am an attorney registered to practice before the U.S. Patent & Trademark Office, having registration no. 31, 768. I am and have been since the filing date of the above application the attorney representing the sole inventor of the above-referenced invention herein disclosed in U.S. patent application 10/706,500, a Method of Improving Airline Luggage Inspection, filed on November 12, 2003. This Declaration is submitted pursuant to 37 CFR § 1.131 in response to the Office Actions dated April 8, 2005 and August 26, 2005 in which October 29, 2003 was cited as the publication date of the earliest prior art reference.

2. My client, David Tropp, first met me in person on October 27, 2003. At that meeting, which took place in my office, he described his invention to me for the purposes of hiring me as a patent attorney to file a United States patent application for his invention. He wanted his patent application filed in a hurry.

3. At that initial meeting, I took notes by hand. The October 27, 2003 date appears in the upper left hand corner of these handwritten notes. The notes are attached

hereto as exhibit A, although I have redacted price quotes and other confidential notations unrelated to the point of this Declaration.

4. At the October 27, 2003 meeting, Mr. Tropp disclosed the entire invention to me. He explained the problem that the invention was intended to address - problems arising from the U.S. Transportation Security Administration's ("TSA") determination to clip airline passengers' luggage in order to check for items prohibited for security reasons. He provided me with articles describing this problem. An example of such an article is attached as exhibit B.

5. The attached exhibit C shows in Mr. Tropp's own handwriting a detailed description of the invention dated December 19, 2002 including a sketch. He handed this to me at the October 27, 2003 meeting. This sketch was ultimately used as the drawings for the patent application in this case filed on November 12, 2003.

6. The sketch forming part of exhibit C shows a special lock that can be opened both by a combination locking mechanism as well as independently by a master key. In addition, the sketch discloses an identification element on the special lock, namely the words "TSA Approved". As described to me by Mr. Tropp at the October 27, 2003 meeting, and as described in the materials he provided me with that day, his idea included going to the TSA to have them approve a particular special lock and then provide that special lock with an identification element that notified the luggage screeners at the TSA that the special lock was one "approved" by the TSA and for which the TSA had the master key, the identification element also serving to help assure luggage consumers that the special lock was one that would not have to be broken into by the TSA luggage screeners.

7. In addition to the aforementioned handwritten notes and articles, see exhibits B and C hereto, Mr. Tropp also provided me at that meeting with a copy of a written proposal that he had submitted to the TSA in January 2003 to have them approve a special lock of the sort described for the purposes of his invention. This proposal, which is dated and notarized on January 12, 2003, is attached as exhibit D hereto. Because of the fact that Mr. Tropp's invention was a method that involved having the agreement of the TSA, Mr. Tropp had submitted his proposal to the TSA. This is what Mr. Tropp told me and it is what the proposal shows.

8. At the October 27, 2003, in addition to providing written materials to me, Mr. Tropp also verbally described all aspects of the invention to me, including the idea of providing a special lock having a combination lock portion and a key lock portion to consumers and getting the consumer to understand that the TSA has agreed to look for an identification element on the special lock telling it that it will not have to clip this special lock, the idea of obtaining agreement from the TSA to recognize a particular lock having the identification element and to inspect luggage having the special lock of this kind without trying to break into it.

9. According to Mr. Tropp at that initial meeting and according to his notes and proposal that he gave me, see exhibits C and D, the special lock was to be applied to an individual piece of airline luggage. The master key would be provided substantially exclusively to the TSA for use by the luggage screeners. See exhibit B.

10. The day after the meeting, on October 28, 2003, I wrote a patent search firm in Arlington, VA providing a brief summary of the invention in a manner useful to performing the patentability search that I had recommended. As can be seen from the

letter attached hereto as exhibit E, I ordered the patentability search on an expedited basis, which meant in one week's time rather than with a two to three week turnaround time and with faster delivery of the results to me. I have redacted from exhibit E confidential information and information unrelated to the point of this Declaration.

11. On or about November 4, 2003, I received a faxed version of a report from the search firm describing the results of the search. The cover letter of this search report is attached as exhibit F. Upon reviewing this, I was dissatisfied since the search seemed to focus on the invention as a lock rather than as a method. Accordingly, I immediately faxed the search firm a letter dated November 4, 2003, see Exhibit G hereto, asking them to revise the search so that it is directed to a method rather than a lock.

12. On or about November 5, 2003 I received the revised results of the search back, see exhibit H hereto showing the initial part of this revised search report, in a form directed to the invention as a method. I evaluated the results and concluded that the invention was patentable, in particular as a method.

13. With the client's authorization, I immediately commenced work on preparing a United States patent application for this invention and continued working on it through and including November 12, 2003 in order to prepare the specification and all the necessary documents for filing as a patent application.

14. On November 12, 2003, one week after receiving the expedited search results, the patent application papers were complete and I filed the patent application in the U.S. Patent & Trademark Office via Express Mail with a Certificate of Express Mailing to that effect.

15. It is absolutely clear to me that David Tropp had conceived of the entire

claimed invention by October 27, 2003 when he first met me. In fact, it is clear to me that he conceived of it in 2002.

16. The above information is provided so that one can see that acting as Mr. Tropp's attorney, we diligently filed the patent application on November 12, 2003 and did so expeditiously by reference to when he first met me on October 27, 2003.

17. It is noted that although Mr. Tropp can easily demonstrate an effective date of this invention that is a lengthy period of time prior to October 29, 2003, and diligence from that date, this Declaration is limited to swearing behind the specific October 29, 2003 reference cited by the examiner, from a point just prior to said date.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statement were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: 10/12/05

Steven Horowitz